

**REMARKS**

Claims 1-16 are pending in this application. Claims 1-5, 7-12, and 14-16 stand rejected and claims 6 and 13 are allowable. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1, 3, 8, 10, and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,262,770 ("Boyce"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Among the limitations of independent claim 1 not present in the cited reference is "a display size obtaining unit which obtains a display size of the image displayed on the display device." Similarly, claims 8 and 15 explicitly recited "obtaining a display size of image displayed on a display device." These features are not disclosed anywhere in Boyce.

The Office Action asserts that the size obtaining unit is disclosed in Boyce at column 18, lines 50-54, stating that "note the sizes 'selected' (i.e., obtained) to be ¼ the size of the main picture." See Office Action at 2. Applicant respectfully disagrees that this section in Boyce discloses a size obtaining unit, it merely discloses a scaling unit.

In Boyce, an Example is given of MPEG compatible digital televisions which operate in picture-in-picture mode. The disclosed system uses two MPEG decoders, a first to decode the full resolution picture and a second to decode the reduced size picture displayed on a second smaller portion of the screen. Boyce goes on to state that "in one embodiment of the present invention, the size of the reduced resolution pictures incorporated into the main picture is selected to be  $\frac{1}{4} \times \frac{1}{4}$  the size of the normal picture. In such an embodiment, each MPEG 8 x 8 pixel block need only be decoded to a size corresponding to a block of 2 x 2 pixels. See Boyce at column 18, lines 50-54. Thus, there is no display size obtaining unit as explicitly recited in Applicant's claim but merely a scaling of each pixel block. Boyce fails to disclose the explicitly recited size obtaining unit in Applicant's claims. The mere ability for the pixel blocks to be scaled does not correspond to the size obtaining unit explicitly recited in Applicant's claim.

Because the size obtaining unit feature is not present in Boyce, Applicant respectfully requests that the rejection of claims 1, 3, 8, 10, and 15 under 35 U.S.C. § 102(e) be withdrawn.

Claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyce. As discussed above, independent claims 1 and 8 are allowable over Boyce, dependent claims 4 and 11 are allowable for at least the same reasons.

Claims 2, 5, 9, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyce in view of U.S. Patent No. 6,370, 192 ("Pearlstein"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

Pearlstein was included not to cure the deficiencies in Boyce discussed above but to show additional limitations which, even if it were to show, does not cure the

deficiencies in Boyce discussed above. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 2, 5, 9, and 12.

Claims 7, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 835,237 ("Ebrahimi"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

Among the limitations of independent claims 7, 14, and 16 not present in Ebrahimi is a color-difference decoding unit which decodes color-difference component in the compressed moving picture, wherein the luminance decoding unit decodes the compressed moving picture in a resolution which is lower than a resolution used by the color difference decoding unit. This feature is not present in Ebrahimi nor is there any suggestion to modify Ebrahimi to arrive at Applicant's explicitly recited invention.

Applicant explicitly claims that the luminance decoding unit decodes the compressed moving picture in a resolution which is lower than a resolution used by the color decoding unit. There is no teaching in Ebrahimi to use a resolution for the luminance decoding different than the color-difference decoding.

In Ebrahimi, when the chrominance signals have a lower resolution, the edge information of the luminance signal is decoded at the resolution of the chrominance signal. The same resolution is always used in Ebrahimi and there is no teaching or suggestion to use different resolutions for either of the signals as explicitly recited in the claims.

The Examiner asserts that since the luminance decoding unit in Ebrahimi decodes a signal at a resolution of the chrominance signal, a lower resolution is used in order to transform the high resolution signal input to the decoder into the low resolution signal (i.e., the luminance decoder uses half resolution), whereas the chrominance

decoder can use a full resolution since the input signal is already a low resolution signal. However, one would not arrive at this conclusion reading Ebrahimi as it merely teaches to use the same resolution for both the luminance and chrominance signals. Thus, there is no teaching or suggestion to use a lower resolution as explicitly recited in Applicant's claim. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By

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